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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,028	11/17/2003	Tae Hoon Kim	2336-221	9725

7590 06/15/2005

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EXAMINER

THAI, LUAN C

ART UNIT PAPER NUMBER

2891

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,028

Applicant(s)

KIM ET AL.

fm

Examiner

Luan Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 14 is/are allowed.
- 6) ☒ Claim(s) 9-13 and 15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bureau et al. (6,492,194).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 9, 11 and 15, Bureau et al. disclose (see figures 2-5) a package sheet (20) for a Surface Acoustic Wave (SAW) filter package comprising: an outline pattern (107) formed along outer peripheries predetermined areas to be mounted with a plurality of SAW filter chips (10), the outline pattern being contacted with a metal shield layer (60, figure 4a-4b) formed on the SAW filter chips and a predetermined region of the package sheet; circular holes (50) covering all adjacent corners of the chip mounting areas (figure 3a) to be mounted with the SAW filter chips and intersected by cutting lines functioning as reference lines for cutting the sheet into a plurality of SAW filter packages (see figures 4a-4b). Although Bureau et al. do not label holes (50) as the claimed "anti-bur holes", the structure of Bureau et al.'s holes (50) do not distinguish from the claimed anti-bur holes (e.g., forming at corners, through the package sheet, the cutting lines going

through, etc.), such holes (50) would have been obvious to be considered as the claimed anti-bur holes. Further, the labels nonetheless are meaningless. The Bureau et al.'s holes structures could anticipate Applicant's claimed structure regardless of whether the holes are labeled "anti-bur holes". See *In re Pearson*, 181 USPQ 642; *Fx parte Minks* 169 USPQ 120; or *In re Swinehart* 169 USPQ 226, all of which make it clear that mere "labels" or "statements of intended use" as we have here in "anti-bur" do not distinguish over Bureau et al.'s holes structure which may be likewise labeled.

Regarding claim 10, Bureau et al. further disclose the outline pattern (107) being formed in the package sheet (20) with a length corresponding to the outer peripheries of the SAW filter chips (10) (see figures 3a and 4a-4b).

3. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bureau et al. (6,492,194) in view of Baba et al. (6,815,869).

Regarding claims 12-13, the proposed package of Bureau et al. discloses the claimed invention as detailed above except for teaching the package sheet comprising at least two layers.

However, a package sheet comprising a plurality of layers is commonly applied in the art, specifically in Surface Acoustic Wave (SAW) device art, as taught by Baba et al. (Col. 5, lines 38+). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the multi-layers package sheet, as taught by Baba, into Bureau et al.'s package, since such multi-layers package sheet is commonly used in the art, and such applying is held to be within the ordinary designing ability expected of a person skilled in the art.

Allowable Subject Matter

4. Claims 1-8 and 14 are allowed.
5. The following is an examiner's statement of reasons for allowance:

The prior art taken either singly or in combination with other prior arts fails to anticipate or fairly suggest at least the method steps of *removing predetermined portions of the protective layer between the SAW filter chips to expose the outline pattern on the package sheet and predetermined portions of the package sheet between the SAW filter chips*, as recited in claim 1, especially when these limitations are considered within the specific combination claimed.

6. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan Thai whose telephone number is 571-272-1935. The examiner can normally be reached on 6:30 AM - 5:00 PM, Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley W. Baumeister can be reached on 571-272-1722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Luan Thai', with a long horizontal flourish extending to the right.

Luan Thai

Primary Examiner

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June 11, 2005